

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES M. LUNDGREEN and LARRY W. BETCHER

Appeal No. 2003-1327
Application 09/375,713

ON BRIEF

Before FRANKFORT, McQUADE, and BAHR, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 8, which are all of the claims pending in this application.

As set forth on page 1 of the specification, appellants' invention is directed to a work-holding device of the type that permits a mechanic or other artisan to conveniently perform

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maintenance operations on an object held by the device in an elevated position above a floor and, more particularly, to a mobile self-supporting stand and work-holding device that can be quickly and easily moved between storage and work locations yet remain stable and secure during the above-noted maintenance operations. At page 1, lines 20-25, while recognizing the desirable aspects of having a stand of the type noted above which is highly mobile, appellants indicate that it is "imperative" that such stands be extremely sturdy and stable, "i.e., 'immobile' during the time that the holding equipment on the stand is actually in use." Independent claim 1 is representative of the subject matter on appeal and a copy of that claim may be found in Appendix 1 of appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Donovan	3,501,037	Mar. 17, 1970
Rolnicki et al. (Rolnicki)	5,378,103	Jan. 3, 1995
Amstutz	5,967,493	Oct. 19, 1999

Claims 1, 2 and 6 through 8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Donovan in view of Amstutz.

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Claims 3 through 5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Donovan in view of Amstutz as applied to claims 1 and 2 above, and further in view of Rolnicki.

Rather than attempt to reiterate the examiner's full commentary with regard to the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellants regarding those rejections, we make reference to the examiner's answer mailed November 13, 2002 for the reasoning in support of the rejections, and to appellants' brief filed August 27, 2002 for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we have made the determinations which follow.

Looking first at the examiner's rejection of claims 1, 2 and 6 through 8 under 35 U.S.C. § 103(a) as being unpatentable over Donovan in view of Amstutz, we note that on pages 3-4 of the answer the examiner has urged that Donovan shows a stand for supporting an object in an elevated position above a floor, wherein the stand includes a rigid frame comprising a base and mast arrangement like that generally set forth in claim 1 on appeal (e.g., base members 11-14 and mast members 16, 17, 22), but lacking a plurality of floor-engaging stabilizer feet arranged in the manner required in appellants' claims on appeal and a pair of laterally spaced wheels of the type required in claim 1 arranged in relation to the stabilizer feet so that the wheels do not contact the floor when all of the feet are engaging the floor and wherein a pair of said feet are disposed forwardly of the wheels to serve as a fulcrum about which the frame may be selectively tilted back to bring the wheels down into contact with the floor so that the frame is supported by the wheels and the stand can be easily moved between work locations.

To account for the above-noted differences, the examiner has looked to the Amstutz patent, urging that this patent teaches use of a mobile stand having a plurality of floor-engaging stabilizer

feet (143 of Figs. 9 and 13) projecting downwardly from a base (119) and a pair of wheels (133) arranged in relation to the stabilizer feet so that the wheels do not contact the floor when all of the feet are engaging the floor and wherein a pair of said feet are disposed forwardly of the wheels to act as a fulcrum (Fig. 13).

Based on the combined teachings of Donovan and Amstutz, the examiner has concluded that it would have been obvious to one of ordinary skill in the art at the time appellants' invention was made to provide Donovan with the floor-engaging stabilizer feet and raised transport wheels of Amstutz, "because the stabilizer feet help provide a more stable working position for the device, wherein the feet prevent the device from moving when movement is not desired" (answer, page 4).

Appellants assert (brief, pages 7-12) that the examiner has failed to establish a *prima facie* case of obviousness, because there would be no reason or motivation for one skilled in the art to combine Amstutz with Donovan since the Donovan device is made for mobility, and already has a means for moving the tractor tire transport holder from one location to another, i.e., the castors

(19). In this regard, appellants further assert (brief, page 10) that the examiner's proposed combination would require the Donovan device to be completely reconfigured and that such extensive modification of the Donovan device would impermissibly change the operation of the tractor tire transport holder therein. In particular, appellants contend that providing Donovan's device with a stable base and then adding a separate dolly to permit movement of the device would not make any sense, and would make Donovan's device unsatisfactory for its intended use as a completely mobile transport device.

Having considered the two applied patents to Donovan and Amstutz, we share appellants' view that there is no motivation, teaching or suggestion in the applied references, whether considered individually or collectively, for the examiner's proposed combination thereof. In our opinion, the examiner has used impermissible hindsight derived from appellants' own teachings in seeking to combine selected portions of the base structure and dolly arrangement of the spring compressor stand in Amstutz with the mobile tractor tire transport holder of Donovan. In that regard, we note that, as our court of review indicated in In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 (Fed.

Cir. 1992), it is impermissible to use the claimed invention as an instruction manual or "template" to piece together isolated disclosures and teachings of the prior art so that the claimed invention is rendered obvious. That same Court has also cautioned against focussing on the obviousness of the differences between the claimed invention and the prior art rather than on the invention as a whole as 35 U.S.C. 103 requires, as we believe the examiner has done in the present case. See, e.g., Hybritech Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 1383, 231 USPQ 81, 93 (Fed. Cir. 1986), cert. denied, 480 U.S. 947 (1987).

Donovan's transport holder is specifically designed for retaining and moving large, heavy rimmed tractor tires, sometimes weighing in excess of two tons (col. 1, line 39), from one location to another. To that end, the support frame therein includes a generally U-shaped base (11, 12, 13, 14) arranged to straddle a tractor tire (Fig. 1), castors (19) secured at remote corners of the base for providing ease of movement of the transport holder, and an upwardly extending mast (16, 17, 22) welded to the base and having a vertically movable carrier frame (25) secured thereto with means (40) for clampingly holding a rimmed tractor tire in position and means (62) for elevating the

tractor tire above the ground surface. By contrast, Amstutz discloses a support stand for a spring compressor, wherein the stand includes a vertical post (5) carrying the spring clamping members and a cruciform base (119) with what appears from Figure 9 to be screw adjustable, floor-engaging feet (143) for leveling the stand. At column 5, line 50, *et seq.*, Amstutz discusses having the cruciform base of the stand therein further constructed to receive a two wheel dolly (126) so that one person can easily move the spring compressor from one location to another. In this regard, note Figures 12 and 13 of Amstutz.

Simply stated, there would be no reason for one of ordinary skill in the art to consider eliminating the castors (19) on the mobile tractor tire transport holder of Donovan and replacing them with a plurality of floor-engaging feet like those seen at (143) in Figure 9 of Amstutz, and to then provide a two wheeled dolly similar to that seen in Figures 10-12 of Amstutz for facilitating movement of the tractor tire transport holder of Donovan in a tilted position like that depicted in Figure 13 of Amstutz, especially remembering that the rimmed tractor tires to be handled by Donovan's transport holder are "exceptionally large and heavy" (col. 1, lines 35-36), e.g., in excess of two tons.

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Since we have determined that the teachings and suggestions found in Donovan and Amstutz would not have made the mobile stand of claims 1, 2 and 6 through 8 on appeal obvious to one of ordinary skill in the art at the time of appellants' invention, we must refuse to sustain the examiner's rejection of those claims under 35 U.S.C. § 103(a).

As for the examiner's rejection of claims 3 through 5 under 35 U.S.C. § 103(a) as being unpatentable over Donovan in view of Amstutz and Rolnicki, we have additionally reviewed the Rolnicki patent, but find nothing therein that provides for that which we have indicated above to be lacking in the examiner's basic combination of Donovan and Amstutz. Moreover, we see no basis whatsoever for even attempting to modify the tractor tire transport holder of Donovan in light of the "swing-type door transporting and elevating apparatus" of Rolnicki. Accordingly, the examiner's rejection of claims 3 through 5 under 35 U.S.C. § 103(a) will likewise not be sustained.

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In light of the foregoing, the decision of the examiner to reject claims 1 through 8 of the present application under 35 U.S.C. § 103 is reversed.

REVERSED

CHARLES E. FRANKFORT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOHN P. McQUADE)	
Administrative Patent Judge)	APPEALS AND
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)	INTERFERENCES
)	
JENNIFER D. BAHR)	
Administrative Patent Judge)	

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Baker & Hostetler LLP
Washington Square, Suite 1100
1050 Connecticut Ave. N.W.
Washington, Dc 20036-5304